

REMARKS

Claims 1, 2, 5, 7, 8, 11, and 13-22 are pending in the present application.

The rejection of Claims 1, 2, 5, 7, 8, 11, 13, and 14 under 35 U.S.C. §112, second paragraph, is obviated by amendment.

Applicants have amended the claims to define the R groups in proper Markush form. As such, this ground of rejection is believed to be moot. It is further noted that the identity of the alkyl and alkenyl groups represented by R₅-R₁₂ has been identified as being 1 to 10 carbon atoms in the claims.

Withdrawal of this ground of rejection is requested.

The rejection of Claims 1, 2, 5, 7, 8, 11, and 13-22 under 35 U.S.C. §103(a) over Naito et al (U.S. 5,292,799) is respectfully traversed.

As stated in the responses filed on April 14, 2006 and May 15, 2006, the claimed invention is relates to a solution for application to a substrate having a hydroxyl group inside, such as paper or fiber materials.

The reaction mechanism between compound 1 and the hydroxyl group (-OH) in paper or fiber materials is shown on page 34 of the present application, wherein the hydroxyl group in paper or fiber materials and the organosiloxane compound (Si-OH) reacted to improve mechanical intensity. This reaction is neither disclosed nor suggested by Naito et al, nor is a composition for performing the same.

More importantly, in view of the fact that the target of the claimed composition and the resultant coated material is paper or fiber materials, in the present application a solvent is needed. This is because the coating materials, represented by formula 1 and 3 (or formula 1,

2, and 3) and the hydrolysable organometallic compound, must penetrate inside paper or the fiber materials in order to access and react with the hydroxyl group in the paper or fiber materials. In contrast, Naito et al disclose a “*solvent-free* cold-setting ternary organosiloxane composition” (see, for example, the Title, the Abstract, the claims, etc.).

Applicants note that MPEP §2141.02 states: “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The disclosure Naito et al that their composition is “solvent-free” would necessarily teach away from the claimed invention and the rejection over this reference must be withdrawn.

Withdrawal of this ground of rejection is requested.

Applicants submit that the present application is now in condition for allowance.
Early notification of such action is earnestly solicited.

Respectfully submitted,

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